

Application No. 09/822,844
Response to 11/17/2004 Action

Attorney's Docket No. 0220-028

REMARKS

Claims 1-4, 6-9, and 11-15 are pending. Independent claim 1 and its dependent claims 2 and 3 have been amended.

The Action objects to claims 1-8 because of a perceived informality. Although it is submitted that it is not necessary for method claims to include the transitional phrase "comprising the steps of" as asserted in the Action, claims 1-3 have been so amended. It is therefore respectfully requested that the objections be reconsidered and withdrawn.

Claims 1-4 and 6-8 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness because of a perceived ambiguity in the recitation of "a first software identification". Claim 1 recites "locating a first software identification in a /dev/dty/ directory . . . in one or more program instructions for said CSN platform". It is believed that this recitation is reasonably clear that the software identification is located in a /dev/dty directory that is in turn in one or more program instructions. This is consistent with the specification, for example, page 10, lines 21-26. Thus, the rejected claims meet the requirements of Section 112, which after all requires only that the claims be reasonably clear to the artisan. As explained in Section 2173.02 of the MPEP:

"Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement."

If the Examiner continues to assert that claim 1 is indefinite, he is respectfully requested to suggest claim language having improved clarity.

Claims 1-4, 7-9, and 12-15 were rejected under 35 U.S.C. § 102(b) for anticipation by U.S. Patent No. Re. 36,394 to Advani ("Advani"), and remaining claims 6 and 11 were rejected under 35 U.S.C. § 103(a) for obviousness over Advani. These rejections should be reconsidered and withdrawn at least because Advani does not disclose or even suggest all of the features recited in Applicants' claims.

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Applicants' claim 1, for example, defines a method of linking a read-only printer (ROP) to a compact service node (CSN) platform at a telecommunication facility. The term "CSN platform" is also positively recited in the body of the claim at several places. On page 3, the Action tacitly admits that Advani does not disclose a CSN platform, and tries to hand-wave past this omission with language about Advani's being "generically applicable" to operating systems. This is not the test for anticipation, which requires disclosure of each and every element of a claim arranged as in the claim.

Claim 1 further recites that a first software identification is "r0d" in a /dev/dty directory. These are two more positive recitations that the Action tacitly admits are not disclosed in Advani and tries to hand-wave past with an unsupported but convenient assertion on page 5 that the application does not attach any "special meaning or significance" to them and thus they appear to be a "design choice". This assertion is not understood. The specification thoroughly discusses these features at pages 10 and 11, for example. Moreover, an issue of "design choice" typically relates to obviousness, not anticipation, and even then, it has been found that the mere fact that a worker in the art could rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. See MPEP § 2144.04.VI.C.

The foregoing discussion of claim 1 is applicable to the other independent claims 9 and 14, so it need not be repeated.

Because Advani fails to disclose all of the elements of claims 1-4, 7-9, and 12-15, it is respectfully submitted that Advani cannot anticipate those claims.

For at least the same reason, Advani also fails as a basis for a *prima facie* case of obviousness against claims 6 and 11. In addition, the Action's attempt to take "official notice" of the Lucent @ CSN-plus platform is noted. This attempt is improper. As set forth in MPEP 2144.03.A, it is not appropriate to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. "For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. [Citation omitted.]" MPEP 2144.03.A.

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It is also believed that Advani would not have supplied any motivation to modify, as suggested by the Action and that there would have been no reasonable expectation that such a complex document could have been successfully modified to yield a working method and system as claimed. In view of the significant differences between the subject matter claimed and Advani, it is unnecessary to discuss these other requirements of a *prima facie* case in detail. Accordingly, it is respectfully requested that the obviousness rejections be reconsidered and withdrawn.

It is believed that this application is now in condition for allowance, and an early Notice of same is respectfully solicited. If the Examiner has any questions, the undersigned attorney may be telephoned at the number given below.

Respectfully submitted,



Michael G. Savage
Registration No. 32,596

Filed February 17, 2005

Potomac Patent Group PLLC
P.O. Box 855
McLean, VA 22101
Tel: 1 919 677 9591

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